

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-5, 9-26 and 30-38 are pending in this application. No claim amendment are presented, thus, no new matter is added.

In the outstanding Office Action, Claims 1-5, 9-24 and 30-35 were rejected under 35 U.S.C. 102(e) as anticipated by Sullivan et al. (U.S. Patent No. 6,477,531, herein "Sullivan"); Claims 1-5, 9-24 and 30-35 were rejected under 35 U.S.C. 103(a) as unpatentable over Grewal et al. (U.S. Patent No. 6,691,159, herein "Grewal") in view of Meyer et al. (U.S. Patent No. 6,601,190, herein "Meyer") and Rangan (U.S. Patent No. 6,412,073); Claims 25-26 and 36-37 were rejected under 35 U.S.C. 103(a) as unpatentable over Grewal, Meyer, Rangan, and House et al. (U.S. Patent No. 6,119,247, hereinafter House); Claim 38 was rejected under 35 U.S.C. 103(a) as unpatentable over Grewal, Meyer, Rangan and Hayward et al. (U.S. Patent No. 6,629,134, herein "Hayward"); Claims 25, 26 and 36, 37 were rejected under 35 U.S.C. 103(a) as unpatentable over Sullivan and House; and Claim 38 was rejected under 35 U.S.C. 103 (a) as unpatentable over Sullivan in further view Hayward.

As an initial matter, Applicants respectfully request that the Information Disclosure Statement filed September 28, 2005, be considered and initialed by the Examiner.

Claims 1-5, 9-24 and 30-35 were rejected under 35 U.S.C. 102(e) as anticipated by Sullivan. Applicants respectfully traverse this assertion, as independent Claims 1, 16 and 32-35 recite novel features clearly not taught or rendered obvious by the applied reference.

A non-limiting embodiment of the claimed invention is directed toward providing online support to a user. To provide a user with support, a two part form is used that asks the user to input information. In addition to this, a browsing record is transmitted along with the

form to a support center. The browsing record allows for an estimation of the operations that the user has tried, (i.e., identification of the user support web pages that the user has looked at). This enables the analysis of the problem and the examination of the effective operation to be carried out more appropriately and more efficiently. When the browsing record information is stored in the user's device, the browsing record information may be added automatically or in response to a user's operation to the E mail sending the information with regard to the problem.¹ Since the form is transmitted after acquiring browser history information the form including the browser information is transmitted after the user has unsuccessfully attempted to perform self-help operations.

Specifically, independent Claim 1 recites, in part, an online support method that gives online support to eliminate a problem arising in a device, comprising the steps of:

- (a) providing a user of the device with a specific form that enables the user to input and transmit information with regard to the problem;
- (b) providing the user of the device with support information, which is prepared in advance for elimination of the problem, prior to said step (a)...
- (c) obtaining browsing record information, which represents a user's browsing record of the support information, in addition to information input into the specific form; and
- (d) ***transmitting the browsing record information and the information input into the specific form to an online support operator.***

Independent Claims 16 and 32-35, while directed to alternative statutory embodiments, recite substantially similar features. Accordingly, the remarks presented below are applicable to each of independent Claims 1, 16 and 32-35.

Turning to the applied reference, Sullivan describes a method for automated technical support in a computer network having a client machine and at least one server. The method allows a user to fill out entries on a form (e.g., Figs. 5-6) in a self-help session to gather

¹ Specification, paragraph 16.

diagnostic data. If this step is unsuccessful, the session may enter a live-help session, wherein a support technician can obtain the information generated based on the self-help session to diagnose a problem.²

Sullivan, however, fails to teach or suggest *transmitting the browsing record information and the information input into the specific form to an online support operator*, as recited in independent Claim 1.

In addressing the “form” feature recited in the pending independent claims, the Official Action relies on Fig. 4 (ref. num. 66 and 68) and Fig. 6 of Sullivan. However, the form depicted in Fig. 6 of Sullivan is not transmitted to an online support operator with a browsing record. Instead, as described at col. 7, line 59-col. 8, line 18, this form is used to allow a user to perform self help diagnostics on the device, by launching a browser to obtain information to help a user. Thus, the information input to the form in Fig. 6 of Sullivan is not transmitted to an online operator, but is instead used to launch a self-help session.

Further, in addressing the feature of “transmitting the browsing record information...” feature, the Official Action relies on col. 12, lines 8-18 of Sullivan. This cited portion of Sullivan, however, describes that “the telemetry data provided by the client side code summarized all the self-help actions the user took, including search strings and those actually traversed.” Thus, Sullivan describes that telemetry data is provided, but fails to teach or suggest that the information input to the self-help form (Fig. 6), or that browsing record information is transmitted to an online support operator, whatsoever.

Further, the method of Sullivan is fundamentally different from that of the claimed invention. The claimed invention recites that support information is provided *in advance*, and the specific form is only filled out and transmitted if the self-help support is not helpful.

² Sullivan, Abstract.

In contrast, the only time a user fills out a form in Sullivan's method, is to obtain a self-help diagnosis.

Therefore, Sullivan fails to teach or suggest *transmitting the browsing record information and the information input into the specific form to an online support operator*, as recited in independent Claim 1.

Claims 25, 26 and 36, 37 were rejected under 35 U.S.C. 103(a) as unpatentable over Sullivan and House, and Claim 38 was rejected under 35 U.S.C. 103 (a) as unpatentable over Sullivan in further view Hayward.

However, as discussed above, Sullivan fails to teach or suggest *transmitting the browsing record information and the information input into the specific form to an online support operator*. Likewise, neither House nor Hayward remedy this deficiency, and therefore, none of the cited references, neither alone, nor in combination, teach or suggest Applicants Claims 25, 26 and 36-38, which include the above distinguished limitations by virtue of independent recitation or dependency. Therefore, the Official Action fails to provide a *prima facie* case of obviousness with regard to any of these claims.

Accordingly, Applicants respectfully request that the rejection of Claims 25, 26 and 36-38 under 35 U.S.C. 103, in view of the above noted references, be withdrawn.

Claims 1-5, 9-24 and 30-35 were rejected under 35 U.S.C. 103(a) as unpatentable over Grewal in view of Meyer and Rangan; and independent Claim 38 was rejected under 35 U.S.C. 103(a) as unpatentable over Grewal, Meyer, Rangan and Hayward. With respect to the rejections based on art, Applicants respectfully traverse the outstanding grounds of rejection because the outstanding Office Action fails to provide a *prima facie* case of obviousness for independent Claims 1, 16, 32, 33, 34, 35, and 38.

With respect to the rejection of Claim 1, Applicants respectfully traverse the rejections. Claim 1 recites, *inter alia*, “wherein ***the specific form comprises a first part that asks the user to input first information generally required for analysis of the problem, and a second part that enables the user to input arbitrary information with regard to the problem.***” In rebutting previously presented arguments directed to this claimed feature, the Official Action cites Grewal, and states that “the Web page of Figure 4 is a first part of the form and the textual dialogue box 212 is a second part of a form. Nowhere has the applicant limited a form to a single website or CGI program.”³

However, independent Claim 1 clearly recites that ***the specific form... comprises a first part... and a second part.*** As depicted at Fig. 10, and as would be obvious to one of ordinary skill in the art, the phrase “***the specific form***” clearly indicates the use of a single questionnaire to which information is input. The website at Fig. 4 of Grewal is not a form, but is instead a website with links allowing a user to navigate through a series of web pages. Further, the textual dialog box merely displays one box that displays a textual interchange between an expert and the user, and can not reasonably be interpreted as being combined with the website at Fig. 4 to be considered ***a specific form***. Thus, Grewal fails to teach or suggest ***a specific form comprising a first part that asks the user to input first information generally required for analysis of the problem, and a second part that enables the user to input arbitrary information with regard to the problem,*** as recited in independent Claim 1.

Further, Meyer and Rangan do not cure the above-noted deficiency in Grewal. The form disclosed in Meyer does not disclose or suggest the claimed two-part form. Meyer only discloses sending an email in a form to obtain user support with one field.⁴ Rangan is not

³ Official Action, p. 12.

⁴ Meyer, Fig. 2.

directed toward obtaining user support and does not disclose or suggest a two-part form as described in Claim 1.

Moreover, Claim 1 also recites, *inter alia*, “obtaining browsing record information, which represents a user's browsing record of the support information, in addition to information input into the specific form,” and “transmitting the browsing record information and the information input into the specific form to an online support operator.” The Office Action again relies on Rangan to disclose this element of Claim 1.

In addressing arguments related to the above noted feature, the Official Action states that Rangan “is relied upon to show that the uploading of browsing information is a well known concept but is not relied upon to show specifically on-line support information.”⁵ (emphasis added)

Specifically, the portion of Rangan cited to in the outstanding Office Action merely discloses managing bookmarks. At col. 8, lines 41-51, Rangan describes how bookmarks may be downloaded onto the same user's local browser or uploaded to the user's homepage. Claim 1 clearly describes that the browsing record represents a user record of ***browsing support information***. As admitted in the Official Action, Rangan does not teach or suggest that the bookmarks are a record of browsing ***support information***, and the Official Action fails to cite any references to remedy this admitted deficiency.

Further, the Official Action states “Rangan teaches the transmission of a browsing record.”⁶ However, Claim 1 requires that the browsing record be transmitted to an online support operator. The user's own browser or own webpage is not an online support operator. Applicants note that none of the words of Claim 1 can be ignored. In re Wilson, 165 USPQ 494, 496 (CCPA 1975).

⁵ Official Action, p. 12.

⁶ Id., p. 6.

Therefore, none of the cited references, neither alone, nor in combination, teach or suggest “obtaining browsing record information, which represents a user's browsing record of the support information, in addition to information input into the specific form,” and “transmitting the browsing record information and the information input into the specific form to an online support operator,” as recited in independent Claim 1.

Furthermore, Applicants respectfully submit that a person of ordinary skill in the art would not combine Grewal, Meyer, and Rangan. The disclosures of Rangan, Grewal, and Meyer do not provide sufficient disclosure of a motivation for transmitting both browsing record information and the claimed specific form.

In rebutting this argument, the Official Action states only that the combination of Grewal, Meyer, and Rangan is proper because “they all relate to data collection techniques via the internet.”⁷ However, the arguments presented in the previous response, partially reiterated below, are not wholly directed to the applied art being non-analogous, but are directed to the lack of motivation to combine the cited references.

Again, the Official Action states that a person of ordinary skill in the art would combine Rangan with Grewal and Meyer because “user’s browsing records are usually stored on a user’s PC.”⁸ This is not a motivation to combine references as it only states a possibility about where browsing records could be stored. Storing browsing records on a user’s PC does not suggest the desirability as to why downloading or uploading bookmarks of Rangan should be combined with Grewal and Meyer.

Furthermore, Applicants respectfully submit that a person of ordinary skill in the art would not be motivated to combine Grewal and Meyer. Grewal specifically discloses problem solving through use of a chat room. Meyer only discloses problem solving by

⁷ Id., p. 12.

⁸ Id., p. 6.

sending email to obtain user support. Grewal teaches away from using a form and discloses that forms are cumbersome, impersonal, and time consuming.⁹ Furthermore, Meyer teaches away from service personnel speaking directly with customers because problems with the operation of computers are often complex.¹⁰ Therefore, one of ordinary skill in the art clearly would not be motivated to combine two references that disparage one another by expressly teaching that the methods used to communicate with user support in each are not sufficient.

"A reference may be said to teach away when a person of ordinary skill in the art, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). To this end, "disclosures in the references that diverge from and teach away from the invention cannot be disregarded", Phillips Petroleum Company v. U.S. Steel Corp., 9 USPQ2d 1461 (Fed. Cir. 1989).

Accordingly, Applicants respectfully submit that a person of ordinary skill in the art would not combine Grewal and Meyer.

In effect, the outstanding rejection does little more than attempt to show that parts of the inventive combination of Claim 1 were individually known in other arts and to suggest that such a showing is all that is necessary to establish a valid case of *prima face* obviousness. The PTO reviewing court recently reviewed such a rationale and dismissed it in *In re Rouffet*, 149 F. 3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) as follows:

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate

⁹ Grewal, col. 1, lines 22-29.

¹⁰ Meyer, col. 1, lines 15-22.

patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. [emphasis added.]

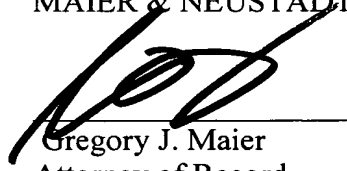
There has been no such showing of those required reasons made in the final rejection.

In view of the above-noted distinctions, Applicants respectfully submit that Claim 1 (and dependent Claims 2-5 and 9-15) patentably distinguishes over Grewal, Meyer, and Rangan, taken alone or in proper combination. Applicants respectfully submit that independent Claims 16, 32-35, and 38 (and dependent Claims 17-31, 36, and 37) patentably distinguish over Grewal, Meyer, Rangan, House, and Hayward taken alone or in proper combination, for at least the same reasons as amended Claim 1.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 1-5, 9-26 and 30-38, is definite and patentably distinguishing over the prior art. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of the application is therefore requested

Respectfully submitted,

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